

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS E. VALIULIS

Appeal No. 2000-1666
Application 08/754,245

HEARD: August 14, 2001

Before ABRAMS, FRANKFORT, and PATE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4 through 8, 12 through 20, 26 through 28, 40 through 49 and 52 through 56. Subsequent to filing the Notice of Appeal, appellant filed amendments (Paper Nos. 29 and 32) requesting cancellation of claims 1, 2, 4 through 9 and 12, and requesting changes to claims 13 through 17 and 19. Those amendments were approved for entry by the

examiner and subsequently entered, thus leaving only claims 13 through 20, 26 through 28, 40 through 49 and 52 through 56 for our consideration on appeal. Claims 21 through 23, 36 through 39, 50, 51, 57 and 58 stand withdrawn from further consideration as being directed to a non-elected species. Collectively, claims 1 through 12, 24, 25 and 29 through 35 have been canceled.¹

Appellant's invention relates to marketing displays, such as merchandising hangers, shelving and racks like those seen in Figures 1 through 8 of the application drawings and to a method of maintaining current merchandising labels in association with merchandise being marketed from such displays by providing the label supporting surface of the display with a release element or release layer that permits easy removal and replacement of adhesive merchandising labels. As indicated in the paragraph bridging pages 2 and 3 of the specification, the release layer

¹ Decided concurrently herewith is the appeal in appellant's copending application S.N. 08/752,529, filed November 20, 1996 (Appeal No. 2000-1665).

Appeal No. 2000-1666
Application 08/754,245

provides readily releasable adherent support for adhesive labels which display product information. More specifically, the release layer, which may be a thin coating of a silicone or similar material, adherently retains and supports an adhesively coated label that is pressed onto that surface and will readily release such a label, i.e. will permit the label to be peeled off cleanly with little effort, normally without tearing or splitting the label or leaving any residue therefrom on the label panel surface. Thereby labels applied to the label panel are exposed outwardly relative to the support for viewing by customers who pass by the display. The labels also are readily removable and replaceable, as well as exchangeable, by merchandising personnel as the facts and circumstances to be displayed change from time to time.

Claims 18, 40 and 54 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness of the claimed subject matter are:

Thalenfeld et al. (Thalenfeld)	4,718,626	Jan. 12, 1988
Petrou	5,628,858	May 13, 1997
		(filed May 18, 1995)

Claims 40 through 49 and 53 stand provisionally rejected

Appeal No. 2000-1666
Application 08/754,245

under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-8, 12-17, 19-32 and 35 of copending Application No. 08/752,529.²

In addition, all of the claims before us on appeal also stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over certain claims of copending Application No. 08/940,859 taken further in view of Thalenfeld and/or Petrou, applied collectively and individually.

Claims 13 through 20, 26 through 28, 40 through 49 and 52 through 56 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thalenfeld in view of Petrou. In this

² On page 5 of the answer, the examiner notes that appellant has filed a terminal disclaimer to obviate this double patenting rejection, but also indicates that the terminal disclaimer has not been processed "since there remains a provisional double patenting rejection over Serial No. 08/940,859, Appellant's terminal disclaimer cannot be processed and entered on the filewrapper, since it is not possible for the Office to enter a terminal disclaimer in part. As a result, the provisional double patenting rejection remains in the case and is repeated here, but is considered to be moot upon final disposition of this Application and processing of the terminal disclaimer."

regard, the examiner is of the view that Thalenfeld shows the invention as claimed except for the fact that this reference lacks a release layer between the label and the label supporting surface. To address this limitation, the examiner turns to Petrou, noting, *inter alia*, that:

Petrou teaches the use of a label attachment element which is attached to a support surface 16, which has a release value which is less than the release value of the surface 16 (Petrou: Col. 1, lines 43-55). It would have been obvious to a person having ordinary skill in the art at the time of Appellant's invention to modify the label supporting surface to have a label attachment element between the label and the label supporting surface in view of Petrou in order to provide a means of using inexpensive permanent pressure sensitive labels on a surface in which the labels are changed frequently (Petrou: Col 2, lines 56-65). (answer, page 12).

Reference is made to the examiner's answer (Paper No. 36) for the examiner's reasoning in support of the above-noted rejections and to the brief (Paper No. 33) for appellant's arguments thereagainst.

OPINION

In arriving at our decision on the issues raised in this

Appeal No. 2000-1666
Application 08/754,245

appeal, we have given careful consideration to the entire record of appellant's application, including the specification and claims, the teachings of the applied prior art references, the evidence of non-obviousness supplied by appellant, and the respective positions advanced by appellant and the examiner. As a consequence of that review we have reached the conclusions which follow.

Looking first to the examiner's rejections based on provisional obviousness-type double patenting, we note that appellant (brief, pages 2-4) has erroneously characterized these rejections as being "moot at this time," because the claims of Application No. 08/752,529 and Application No. 08/940,859 relied upon in the rejections were not yet allowed. Accordingly, appellant has merely urged that these rejections "will be dealt with in whichever of the applications is appropriate in due course." In response, the examiner has remained silent in the answer and has not challenged appellant in any way on this characterization of the double patenting

Appeal No. 2000-1666
Application 08/754,245

rejections. Unfortunately, the problem has arisen that Application No. 08/940,859 was issued as U.S. Patent No. 6,145,231 on Nov. 14, 2000. Thus, one or more of the examiner's obviousness-type double patenting rejections involving this application may no longer be valid and, at the very least, the double patenting rejections based thereon will no longer be provisional. Neither appellant or the examiner has addressed either of these issues. Accordingly, we REMAND this application back to the examiner for consideration of the obviousness-type double patenting rejections now that the application (08/940,859) relied upon therein has issued as a U.S. patent.

As for the provisional double patenting rejection of claims 40 through 49 and 53 of the present application based on claims of copending Application No. 08/752,529, given the lack of any responsive argument from appellant and the fact that appellant has already filed a terminal disclaimer addressing this rejection (not yet processed), we believe it appropriate to summarily sustain this rejection.

Regarding the examiner's rejection of claims 13 through 20, 26 through 28, 40 through 49 and 52 through 56 under 35 U.S.C. § 103(a) based on Thalenfeld and Petrou, we have reviewed the applied references and agree with the examiner that one of ordinary skill in the labeling art would have found it prima facie obvious to employ the release layer labeling approach disclosed in Petrou in association with the merchandise holder and adhesive label of Thalenfeld so as to gain the advantages discussed in Petrou at column 1, lines 36-58, and set forth in claims 4 and 5 of Petrou.

While we consider that the examiner's combination of the applied references would have rendered obvious the method broadly set forth in claims 40 through 49, 52 and 53 on appeal, we must agree with appellant (brief, page 24) that neither Thalenfeld nor Petrou makes any reference whatsoever to merchandising support shelving or to labeling on such shelving as is required in claims 13 through 20, 26 through 28 and 54 through 56 on appeal. With regard to the later group of claims, the examiner's position (answer, page 15) that the

Appeal No. 2000-1666
Application 08/754,245

label holder (30) on the display hook of Thalenfeld is a "shelf," is unreasonable. Accordingly, we will not sustain the examiner's rejection of claims 13 through 20, 26 through 28 and 54 through 56 on appeal under 35 U.S.C. § 103(a).

Having arrived at the conclusion that the evidence of obviousness as applied by the examiner in the rejection of claims 40 through 49, 52 and 53 on appeal is sufficient to establish a prima facie case of obviousness, we also recognize that evidence of secondary considerations, such as that presented by appellant in this application must be considered and weighed in route to a determination of obviousness/nonobviousness under 35 U.S.C. § 103. Accordingly, we consider anew the issue of obviousness with regard to claims 40 through 49, 52 and 53 on appeal under 35 U.S.C. § 103, carefully evaluating and weighing both the reference evidence relied upon by the examiner and the objective evidence of nonobviousness provided by appellant. See Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) and In re Piasecki, 745

Appeal No. 2000-1666
Application 08/754,245

F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Appellant has submitted five declarations, i.e., from Stanley C. Valiulis, Robert W. Harrell, Carol Hopson, Theodore J. Stipanovich, and Frank N. Shope. According to the examiner (answer, page 14), those declarations are entitled to little weight because 1) there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long; and 2) there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references (Thalenfeld and Petrou) and still were unable to solve the problem.

On the whole, our evaluation of the evidence submitted by appellant reveals clear evidence of the existence of a labeling problem associated with merchandising display supports recognized in the merchandising industry for a long period of time and also that efforts have been made, for many years, by those who design and sell such merchandising supports, as well as by those who use such supports, to solve

this labeling problem, without any satisfactory success. See paragraphs 3-6, 11 and 12 of the Valiulis declaration; paragraphs 2-5 of the Harrell declaration; and paragraphs 2-4 of the Hopson, Stipanovich, and Shope declarations. In addition, we find from the evidence submitted by appellant that those skilled in the art of merchandising supports and labeling for such supports have found appellant's claimed invention to be a solution to the labeling problem and, thus, to satisfy the long-felt need. See paragraphs 13-26 of the Valiulis declaration; paragraphs 6-8 of the Harrell declaration; paragraphs 5-10 of the Hopson declaration; paragraphs 5-7 of the Stipanovich declaration; and paragraphs 5 and 6 of the Shope declaration. In this regard, we agree with appellant's arguments put forth on pages 24-27 and 37-40 of the brief. More particularly, we agree with appellant (brief, pages 38-40) that the examiner's reasons, set forth above, for not giving the declaration evidence adequate weight are without foundation (factually or legally) and are therefore unpersuasive.

Appeal No. 2000-1666
Application 08/754,245

Thus, having now carefully considered all of the evidence of nonobviousness supplied by appellant, and weighed that evidence along with the evidence of obviousness relied upon by the examiner, we reach the conclusion that appellant's invention as set forth in claims 40 through 49, 52 and 53 on appeal would not have been obvious to the person of ordinary skill in the art within the meaning of 35 U.S.C. § 103. The evidence of nonobviousness taken as a whole, in our view, clearly outweighs the evidence of obviousness relied upon by the examiner.

In summary:

The examiner's provisional rejection of claims 40 through 49 and 53 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-8, 12-17, 19-32 and 35 of copending Application No. 08/752,529 is sustained.

The examiner's rejection of claims 13 through 20, 26

Appeal No. 2000-1666
Application 08/754,245

through 28, 40 through 49 and 52 through 56 under 35 U.S.C. § 103(a) as being unpatentable over Thalenfeld in view of Petrou is not sustained.

As for the double patenting rejections based on Application No. 08/940,859, we REMAND this application back to the examiner to reconsider the provisional nature of the obviousness-type double patenting rejections now that the application (08/940,859) has issued as a U.S. patent.

In light of the foregoing, the decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Appeal No. 2000-1666
Application 08/754,245

Regarding an affirmed rejection, 37 CFR § 1.197(b)
provides:

(b) Appellant may file a single request for rehearing
within two months from the date of the original decision . . .
.

The effective date of the affirmance is deferred until
conclusion on the proceedings before the examiner unless, as a
mere incident to the limited proceedings, the affirmed
rejection is overcome. If the proceedings before the examiner
does not result in allowance of the application, abandonment
or a second appeal, this case should be returned to the Board
of Patent Appeals and Interferences for final action on the
affirmed rejection, including any timely request for rehearing
thereof.

This application, by virtue of its "special" status,
requires immediate action, see MPEP § 708.01 (Seventh Edition,
Rev. 1, February 2000).

Appeal No. 2000-1666
Application 08/754,245

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART AND REMANDED

Appeal No. 2000-1666
Application 08/754,245

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Administrative Patent Judge)	
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